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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,255	01/14/2002	Klaus Schelberger	48648DIV	1888

26474 7590 06/16/2004  
KEIL & WEINKAUF  
1350 CONNECTICUT AVENUE, N.W.  
WASHINGTON, DC 20036

EXAMINER

ROBINSON, BINTA M

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/044,255

Applicant(s)

SCHELBERGER ET AL.

Examiner

Binta M. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### Detailed Action

The applicant elected the group I invention at paper no. 7. The restriction requirement is modified to be drawn to the fungicidal mixture comprising a compounds an amide compound of the formula I where A is as claimed, R1 is as claimed, R2 is substituted phenyl or phenyl substituted with all other groups claimed except that it can't be condensed, and a compound of formula III, a compound selected from the group consisting of a compound of formula IV, or V, or V1a, V1b, VII, or VIII, or IXa or IXb. The restriction is made FINAL.

The 112, second paragraph rejection of claim 10 at paper no. 11 will be withdrawn in light of applicant's amendment at paper no. 11.

(new rejections)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 1-17 are rejected because the phrase "at least one active ingredient of formula IV or V" in claim 1, line 30, and all other occurrences throughout claims 2-17, renders claim 1 indefinite. It is unclear if the composition must contain as an additional second active components any one of compounds selected from III, IV, V, Via, Vib, VII, VIII, IXa or IXb or must contain a pyrimidine compound of formula III, and

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at least one active ingredient of the formula IV or V. It is ambiguous as to whether or not the composition contains only 2 active components or at least three or more active components. To overcome this rejection, it is suggested that the applicant puts the term "or" after each second active component compound, if in fact, each of the compounds, c-g are second active component compounds. It is further suggested that the phrase "at least one active ingredient" in line 30, of the claim 1, is deleted. It is also suggested tat the term "and" in claim 1, line 6, page 5 be amended to --or--.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 10, 11, 12, of U.S. Patent No. 6365608. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent discloses the fungicidal composition containing the instant amide compound of formula I and at least a second active ingredient selected from a subgenus of the compounds disclosed in the instant claims.

US Patent 6365608 teaches the instant composition as shown in claim 1 containing an amide compound of formula I wherein A, R1 and R2 are as defined at lines 25-50 at column 16, and wherein the second active ingredient is selected from dicarboxamides, or the instant dinitroaniline of formula VIII. At column 16 and 17, see claim 1. The difference between the prior art compound and the instantly claimed compounds is the teaching of a composition wherein the second active component is select from a subgenus of compounds found in the instant claims. In the US Patent 6365608 compound, the second active component is selected from dicarboxamides, or the instant dinitroaniline of formula VIII. In the instant compound, the second active component is selected from the group consisting of a pyrimidine compound of formula III, an active ingredient of formula IV or V, IV, or V or the dicarboxamide compounds of formulas Via, Vib, or VII, or the dinitroaniline compound of formula VIII or the arylsulfamide compound of formula IXa or IXb. It would have been obvious to one of ordinary skill in the art to select various known radicals within a genus to prepare structurally similar compounds. Accordingly, the compounds are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

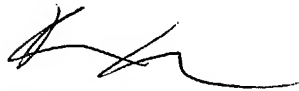
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699.


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A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)-272-1600.



BMR  
June 10, 2004



JOSEPH K. MCKANE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600